

REMARKS

In the Office Action mailed June 16, 2008 (hereinafter "Office Action"), the Examiner objected to claims 9-13 because of informalities; rejected claims 1, 3-5, 9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,481,710 to Keane et al. (hereinafter, "*Keane*") in view of U.S. Patent No. 6,185,591 to Baker et al. (hereinafter, "*Baker*"); rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*, and in further view of "HTML 4.01 Specification," December 1999 (hereinafter "*HTML1999*"); rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*, and in further view of U.S. Patent No. 6,167,455 to Friedman et al. (hereinafter, "*Friedman*"); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*, and in further view of U.S. Patent No. 5,524,205 to Lomet et al. (hereinafter, "*Lomet*"); and rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*, and in further view of U.S. Patent No. 6,543,006 (hereinafter "*Zundel*").

By this amendment, Applicants have amended claims 1, 3, 9-11, and 14 to clarify aspects of the invention. No new matter has been added. Accordingly, claims 1-6 and 8-14 remain pending.

In light of the foregoing amendments and based on the reasoning presented below, Applicants respectfully traverse the objections to the claims. In addition, Applicants respectfully traverse the rejection of claims under 35 U.S.C. § 103(a), and request allowance of pending claims 1-6 and 8-14.

Claim Objections

The Examiner objected to claims 9-11 for reciting the limitation “the at least one data structure.” Applicants traverse this objection but to advance prosecution Applicants have amended claims 9-11 to recite “the at least one data structure of the plurality of data structures,” as the Examiner suggested. The Examiner objected to claims 12 and 13 because of their dependence from claim 9. The amendment to claim 9 cures any deficiency of claims 12 and 13.

The Examiner objected to claim 9 as containing the typographical error “the at least one application controls.” Applicants thank the Examiner for pointing out this typographical error. Applicants have amended claim 9 to read “the at least one application control,” as the Examiner suggested.

In light of the foregoing amendments, Applicants respectfully request reconsideration and withdrawal of the objection to claims 9-13.

Claim Rejection Under 35 U.S.C. § 103(a)

In light of the foregoing claim amendments, Applicants request reconsideration and withdrawal of the rejection of claims 1-6, 8-14 under 35 U.S.C. § 103(a) as being obvious over the cited art. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. §2143.01(III)*, internal citation omitted.

In addition, when “determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been established because the prior art does not render obvious the claims.

A. Claims 1, 3-5, and 14

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*. As currently amended, claim 1 incorporates the steps “determining whether the change affects the data state of the control; determining whether the change affects the view state of the control.” In Office Action, page 6, the Examiner cites *Keane* (column 4, lines 13-25) as teaching “determining whether the change affects the data state or the view state of the control.” At the portion cited by the Examiner, *Keane* discloses (column 4, lines 13-25):

When the user requests a menu (at decision block 43 of FIG. 3) the application inquires of the undo/redo service, at decision block 67, whether there are any packets to be undone.... If the undo stack is not empty, then the undo/redo service returns the text string from the top packet of the undo stack and the application enables the undo action with the string returned from the undo/redo service, at block 71. Thus, in FIG. 2, menu 31 of window 15 includes "UNDO TYPING", which indicates that the text string from the top packet of the undo stack is "TYPING".

Therefore, *Keane* appears to disclose determining “whether there are any packets to be undone,” (see *Keane* column 4, lines 15-16, and FIG. 4). However, *Keane* does not disclose “determining whether the change affects the data state of the control” and “determining whether the change affects the view state of the control.”

Other gaps exist between the cited references and the subject matter of claim 1. *Keane* teaches “the application builds and gives to the undo/redo service a packet that contains at least the identity of the object or objects acted upon by the action and instructions that, when applied to the object or objects, will cause the action to be undone” (*Keane*, column 1, lines 36-40). *Keane* also teaches “Then the service executes that packet's undo code block at block 81. Again, the code block, when

applied to the object or objects of the packet, will cause the action to be undone,”
(*Keane*, column 4, lines 41-43). The Examiner states that *Keane* does not disclose
(Office Action, page 5):

- “each control having a control data structure”
- “storing the state of the control in the control data structure”
- “storing the updated state of the control in the control data structure”

The Examiner cites *Baker* as teaching these missing limitations (Office Action, page 5). Even if the Examiner is correct, *Baker* cannot be combined with *Keane* to cure the deficiencies of *Keane*. *Keane* requires a code block “when applied to the object or objects of the packet, will cause the action to be undone.” However, as characterized by the Examiner, *Baker* teaches the “storing the updated state of the control... in the control data structure,” (Office Action, page 5). Because *Baker* does not teach creating a code block “when applied to the object or objects of the packet, will cause the action to be undone,” *Baker* cannot be combined with *Keane*. Combining *Baker* and *Keane* in the suggested manner would render *Keane* inoperable for its intended purpose.

For at least the above-outlined reasons, neither the combination of *Keane* and *Baker*, nor any obvious variant thereof, teaches or suggests the combination of elements of claim 1. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 1.

Claims 3-5, are also nonobvious at least by virtue of their dependence on nonobvious claim 1. Therefore Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) of these claims as well.

Independent claim 14, although of differing scope, recites elements similar to that of independent claim 1, and is therefore allowable for at least the same reasons. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 14.

B. Claims 9 and 11-13

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker*. As currently amended, claim 9 incorporates the steps “determining whether the change affects the data state of the at least one application control” and “determining whether the change affects the view state of the at least one application control.” Neither *Keane* nor *Baker* teaches this limitation.

For at least the above-outlined reasons, neither the combination of *Keane* and *Baker*, nor any obvious variant thereof, teaches or suggests the combination of elements of claim 9. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 9.

Claims 11-13, are also nonobvious at least by virtue of their dependence on nonobvious claim 9. Therefore Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) of these claims as well.

C. Claim 2

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker* and in further view of *HTML1999*. The Examiner cites *HTML1999* as teaching “wherein the multiple types of controls include one ore more of a radio button control type, a table control type, and a tray control type” (Office Action,

page 11). However, even if the Examiner's characterization is correct, this does not, *inter alia*, cure the deficiencies set forth above and the failure of *Keane* in view of *Baker* to disclose "determining whether the change affects the data state of the control" and "determining whether the change affects the view state of the control" as recited in claim 1 from which claim 2 depends.

For at least the above-outlined reasons, neither *Keane* and *Baker*, nor any obvious variant thereof, teaches or suggests the combination of elements of claim 1, from which claim 2 depends. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 2.

D. Claim 6

Applicants respectfully traverse the rejection of claim 6 under 35 U.S.C. §103(a) as being obvious over *Keane* and *Baker* and *Friedman*. A *prima facie* case of obviousness has not been established because, among other things, the cited art fails to teach or suggest each and every element of Applicants' claims.

By virtue of its dependence from independent claim 1, claim 6 calls for a combination including, for example, "determining whether the change affects the data state of the control" and "determining whether the change affects the view state of the control" As discussed above, *Keane* and *Baker* fail to teach or suggest at least this element of claim 1.

The Examiner cited *Friedman* as teaching "wherein restoring the state of the control includes restoring the state of another control that shares data with the control" (Office action, p. 12). Even assuming the Examiner's characterization of *Friedman* is

correct, *Friedman* fails to cure the deficiencies of *Keane*, as discussed above. That is, *Friedman* also fails to teach or suggest at least “determining whether the change affects the data state of the control” and “determining whether the change affects the view state of the control” as recited in independent claim 1, from which claim 6 depends.

For at least the above-outlined reason, neither *Keane*, nor *Baker*, nor *Friedman*, nor any combination thereof, teaches or suggests the combination of elements of claim 1 from which claim 6 depends. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 6.

E. Claim 8

Applicants respectfully traverse the rejection of claim 8 under 35 U.S.C. §103(a) as being obvious over *Keane* and *Baker* in further view of *Lomet*. A *prima facie* case of obviousness has not been established because, among other things, the cited art fails to teach or suggest each and every element of Applicants' claims.

By virtue of its dependence from independent claim 1, claim 8 calls for a combination including, for example, “determining whether the change affects the data state of the control” and “determining whether the change affects the view state of the control” As discussed above, *Keane* and *Baker* fail to teach or suggest at least this element of claim 1.

The Examiner cited *Lomet* as teaching “wherein restoring the state of the control occurs prior to transmitting the state of the control to a server” (Office Action, page 13).

Even assuming the Examiner's characterization of *Lomet* is correct, *Lomet* fails to cure the deficiencies of *Keane* and *Baker*, as discussed above. That is, *Lomet* also fails to teach or suggest at least "determining whether the change affects the data state of the control" and "determining whether the change affects the view state of the control" as recited in independent claim 1.

For at least the above-outlined reason, neither *Keane*, nor *Lomet*, teach or suggest the combination of elements of claim 1, from which claim 8 depends. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 8.

F. Claim 10

The Examiner rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Keane* in view of *Baker* and in further view of *Zundel*.

By virtue of dependence from independent claim 9, claim 10 calls for a combination including, for example, "determining whether the change affects the data state of the at least one application control" and "determining whether the change affects the view state of the at least one application control." As discussed above, *Keane* and *Baker* fail to teach or suggest at least this element of claim 9.

The Examiner cited *Zundel* as teaching "wherein the at least one of the plurality of data structures is at least one data tree" (Office Action, page 14). Even assuming the Examiner's characterization of *Zundel* is correct, *Zundel* fails to cure the deficiencies of *Keane*, as discussed above. That is, *Zundel* also fails to teach or suggest at least "determining whether the change affects the data state of the at least one application

control” and “determining whether the change affects the view state of the at least one application control” as recited in independent claim 9.

For at least the above-outlined reasons, neither *Keane* nor *Baker* nor *Zundel*, nor any combination or obvious variant thereof, teaches or suggests the combination of elements of claim 10, which depends from independent claim 9. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claim 10.

Conclusion

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 22, 2008

By: William J. Brogan (BROGAN), Reg # 43,515
for Jeffrey A. Berkowitz
Registration No. 36,743